

## **REMARKS**

Claims 1-24 are pending in the application.

Please amend the last paragraph on page 6 and continuing onto page 7 as set forth herein. Please cancel Claim 17. Please amend Claims 6, 7 and 9 as set forth herein. No new matter has been added.

The Examiner objected to the claims. The Examiner rejected Claims 6 and 7 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner rejected Claims 9-16 under 35 U.S.C. §101 as directed to non-statutory subject matter. The Examiner has rejected Claims 1, 2, 8-10, 16, 18 and 24 under 35 U.S.C. §102(b) as being anticipated by Luther (U.S. Patent 5,500,919). The Examiner has rejected Claims 3-7, 11-15, 19-23 under 35 U.S.C. §103(a) as being unpatentable over Luther in view of Lu et al. (U.S. Patent 5,819,260).

Regarding the Examiner's objection to the claims, the Examiner stated that Claims 18-24 were misnumbered, and should be renumbered 17-23. It is respectfully submitted that renumbering of claims is not permitted under 37 C.F.R. 1.126 and MPEP 608.01(j), and therefore applicants have cancelled Claim 17.

Based on at least the foregoing, withdrawal of the objections to Claims 18-24 is respectfully requested.

Regarding the rejection of Claims 6 and 7 under §112, first paragraph, the Examiner states that "prediction algorithm" is not described in the specification. Applicants respectfully disagree. On page 7 of the written description the rare sequence detector is described in detail. Several variations are presented. One variation states that the rare sequence detector 201 can be programmed to predict when a difficult word or word pair has been encountered. See Specification at page 7, lines 11-12.

In addition, the prediction algorithm is further described in original Claim 7 itself. As original filed claims are part of the originally filed application, the prediction algorithm is in fact fully and properly described in the specification. Still further, the last paragraph on page 6 and continuing onto page 7 has been amended to include the recitations contained in originally filed Claim 7.

Based on at least the foregoing, withdrawal of the rejection of Claims 6 and 7 under §112, first paragraph, is respectfully requested.

Regarding the rejection of Claims 9-16 under §101, the Examiner stated that these claims are directed to non-statutory subject matter. The Examiner bases this rejection on an allegation that the rare sequence detector is not “explicitly and deliberately” defined in the specification. Claim 9 has been amended to also recite pausing the output from the speech synthesizer of the synthesized speech of the uncommon word to offset the uncommon word from its surrounding speech.

Initially, Applicants request clarification as to the basis of the rejection. The rejection is stated as a rejection under §101 but the statements contained in the Office Action read as a rejection under §112, second paragraph.

Either way, Applicants respectfully submit that the rare sequence detector is statutory and is adequately defined in the specification. Applicants direct the Examiner to page 6, line 26 – page 8, line 22 wherein the rare sequence detector is described in great detail.

Further, the U.S. Court of Appeals for the Federal Circuit has further confirmed that subject matter similar to that recited in Claim 9 is indeed patentable subject matter. The Court states in *In re Comiskey* (2006-1286, September 20, 2007):

When an unpatentable mental process is combined with a machine, the combination may produce patentable subject matter, as the Supreme Court’s

decision in *Diehr* and our own decisions in *State Street Bank* and *AT&T* have confirmed . . . While the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter . . . these claims in combining the use of machines with a mental process, claim patentable subject matter.

Claim 9 recites, in part, the use of several machines, namely, a system, a speech synthesizer, a rare sequence detector, an output of the speech synthesizer. Claim 9 does in fact recite patentable subject matter under §101.

Based on at least the foregoing, withdrawal of the rejection of Claims 9-16 under §101 is respectfully requested.

Regarding the rejection of independent Claims 1, 9 and 18 under §102(b) the Examiner states that Luther anticipates each and every element of the claims. Applicants respectfully disagree.

Each of Claims 1, 9 and 18 relate to a system or method that determines if uncommon words exist in certain text, and if it is determined that an uncommon word exists in the text, pausing the output from the speech synthesizer of the synthesized speech of the uncommon word to offset the uncommon word from its surrounding speech.

Luther discloses a graphics user interface for controlling text-to-speech conversion. Luther discloses at col. 5, lines 5-6 that words that do not match a spelling dictionary are spelled out.

The Examiner alleges that this pausing to offset the uncommon word from its surrounding speech can be anticipated by the spelling out of a word. The spelling of a word is not and cannot be equated with pausing the output from the speech synthesizer of the synthesized speech of the uncommon word to offset the uncommon word from its surrounding speech.

**MPEP §2131 Anticipation, clearly states that to anticipate a claim, the reference must teach every element of the claim.**

**Based on at least the foregoing, withdrawal of the rejection of Claims 1, 9 and 18 under §102(b), is respectfully requested.**

**Regarding the rejection of Claims 3-7, 11-15, 19-23 under §103(a) the Examiner states that Luther in view of Lu et al. renders the claims unpatentable. Applicants respectfully disagree.**

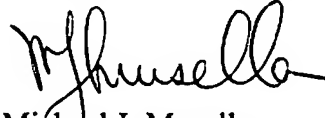
**Lu et al. discloses a phrase recognition method and apparatus. Claims 3-7, 11-15, 19-23 are believed to be in condition for allowance at least by virtue of their dependence on their respective amended independent claims.**

**Based on at least the foregoing, withdrawal of the rejection of Claims 3-7, 11-15, 19-23 under §103(a), is respectfully requested.**

**Independent Claims 1, 9 and 18 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2-8, 10-16 and 19-24, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 2-8, 10-16 and 19-24 is respectfully requested.**

Accordingly, all of the claims pending in the Application, namely, Claims 1-16 and 18-24, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Musella", written over the printed name.

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